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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/526,855	03/17/2000	Hyun K. Kim	15280W003000	3023

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EXAMINER

BADIO, BARBARA P

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 02/14/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/526,855

Applicant(s)

KIM ET AL.

Examiner

Barbara P Badio, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) 4,9-23,26-48 and 50-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-8,24,25 and 49 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: ____ |

Final Office Action on the Merits

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Duplicate Claims

2. The objection to claim 6 under 35 USC 101 as being a substantial duplicate of claim 1 is withdrawn.

Claim Rejections - 35 USC § 102

3. The rejection of claims 1-3, 6-8 and 49 under 35 USC 102(b) over Neef et al. (EP 0,129,499) is withdrawn.
4. The rejection of claims 1-3, 6-8 and 49 under 35 USC 102(b) over Cook et al. is withdrawn.

Claim Rejections - 35 USC § 103

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5. The rejection of claims 1-3, 5-8, 24, 25 and 49 under 35 USC 103(a) over Scholz et al. ('886) is maintained.

Applicant argues that the reference does not provide motivation to modify the prior art compounds or the required reasonable expectation of success. Applicant's argument was considered but not persuasive for the following reasons.

The examiner is unclear as to why Scholz would have to modify the compounds taught since the genus taught by the reference encompasses the claimed compound. If applicant's argument is that the reference does not exemplify a compound having a 17β -acyl group, it is noted that one has to evaluate the reference based on what it teaches and not just on what it exemplifies. Based on the teachings of Scholz, the 17β position is substituted by one of eight group (see col. 2, lines 19-38). Therefore, substituting the group exemplified by the prior art in the 17β -position with one of other seven groups would be obvious to the ordinary artisan in the art. For example, it would be obvious to substitute the 17β -propinyl group of examples 3 and 4 with the acyl group taught by Scholz with the reasonable expectation that the compound would have antigestagen properties.

Applicant also argues that Scholz does not provide a reasonable expectation of success. It is not clear what applicant means by "a reasonable expectation of success". If applicant's argument is that the reference does not show that compounds having a 17β -acyl group are antigestagenic, it is noted that the ordinary artisan based on the teachings of the reference would have the reasonable expectation that any of the compounds of the genus taught by the reference, including those of the instant claims, would have similar properties and, thus, would possess antigestagenic properties. Again, it is noted that the reference has to be evaluated for what it teaches the ordinary artisan in the art and, applicant has not provided evidence contrary to what the skilled artisan would expect based on the teachings of Scholz.

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For these reasons and those given in Paper No. 10, the rejection of claims 1-3, 5-8, 24, 25 and 49 under 35 USC 103(a) over Scholz et al. ('886) is maintained.

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6. **The rejection of claims 1-3, 5-8, 24, 25 and 49 under 35 USC 103(a) over Peeters ('787) is maintained.**

Applicant argues (a) that the reference does not teach or suggest the claimed compounds and (b) that the claimed compounds possess properties that are lacking in the prior art compounds. Applicant's argument was considered but not persuasive for the following reasons.

Applicant argues that the reference teaches a large number of compounds and that there is no teaching or suggestion to select the particular substituents from the lists of many, many different substituents to produce the claimed compounds. Applicant's attention is directed to col. 2, lines 44-54 the preferred compounds of Peeters. The difference between the preferred compounds and the presently claimed compound is the substituent attached to position 17 β (or substituent R₅ of Peeters). Peters teaches R₅ is hydroxyl or selected from three other groups (see col. 2, lines 35-38). One of the three groups taught is an acyl group that can be substituted as claimed by the instant claims. Therefore, the reference provides sufficient guidance to enable the ordinary artisan to select the claimed compounds from the genus taught. In addition, unlike In re Baird, the instant claims are also drawn to numerous compounds some of which are not taught by the reference. Thus, like Peeters, the instant claims encompass a large

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number of compounds and when one considers the substitution at C-3, it contains compounds not taught by the reference.

Applicant also argues that the claimed compounds possess properties that are lacking in the compounds taught by Peeters. Applicant has not provided any factual evidence to support the argument that the claimed compounds have properties not possessed by the prior art compounds. In addition, there is no requirement that the prior art must suggest that the claimed compounds have the same or similar utility as that discovered by applicant in order to support a legal conclusion of obviousness. In re Dillon, 919 F.2d 688, 696, USPQ 2d 1897, 1904 (Fed. Cir. 1990). An obviousness rejection is proper as long as the prior art suggests a reason or provides motivation to make the claimed invention, even where the reason or motivation differs from that discovered by applicant.

For these reasons and those given in Paper No. 10, the rejection of claims 1-3, 5-8, 24, 25 and 49 under 35 USC 103(a) over Scholz et al. ('886) is maintained.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone Inquiry

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P Badio, Ph.D. whose telephone number is 703-308-4595. The examiner can normally be reached on M-F from 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on 703-308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


Barbara P Badio, Ph.D.
Primary Examiner
Art Unit 1616

BB
February 13, 2002